

## REMARKS

### I. Introduction

In response to the pending Office Action, Applicants have amended claims 1, 2 and 10 to eliminate the “capable of” language from the claims. In addition, claim 10 was amended to depend from only claim 1, and new claim 11, which tracks claim 10 but depends on claim 2, was added. Further, the Abstract was amended so as to comply with the 150 word limit. Finally, the specification has been amended to correct inadvertent errors. Support for the amendments to the specification can be found, for example, in Tables 1 and 3. No new matter has been added.

For at least the reasons set forth below, it is respectfully submitted that all pending claims are in condition for allowance.

### II. Double Patenting Rejection

Claims 2, 8 and 9 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 6-10, 12, 13, 18-25 and 27-18 of copending Application Ser. No. 11/642,472. Applicants respectfully submit that this rejection be withdrawn for the following reasons.

As no claims of either application have been indicated to be allowable, it is respectfully submitted that there is no actual basis for the rejection at this time, which is confirmed by the pending rejection as the rejection is only a provisional rejection. Indeed, a response amending the claims of the ‘472 application was filed in the ‘472 application on November 20, 2009. As the Examiner is well aware, the claims of an application may be amended during prosecution, thereby eliminating any double patenting issue.

It is further noted that the above-identified application is the earlier filed application with regard to the '472 application. Specifically, the instant application has a priority date of March 17, 2003 based on the claim of priority to PCT/JP03/03190. The earliest effective filing date of the '472 application is September 5, 2003 based on the claim of priority to USP App. Ser. No. 10/656,483. It is also noted that the '472 application is now assigned to both Panasonic Corporation and Sumitomo Metal Industries, Ltd., as a result of the assignment recorded on May 13, 2004.

Thus, in the event a double patenting rejection remains upon allowance of the claims of this application and the claims of the '472 application, or another rejection is raised, such rejections should be raised in the '472 application, as the '472 application is the later filed application and does not constitute prior art to the instant application under 35 U.S.C. §§ 102 or 103. Indeed, as set forth in Section 804 of the M.P.E.P. "if a provisional nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier filed application to issue as a patent without a terminal disclaimer."

As such, it is respectfully submitted that the claims of the instant application are in condition for allowance, and it is requested that the instant application be passed to issue for the reasons set forth above.

**III. Conclusion**

Having fully and completely responding to all outstanding issues in the Office Action, Applicants respectfully submit that all pending claims are now in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Date: 1/27/10

By: 

Michael E. Fogarty  
Registration No.: 36,139

600 13<sup>th</sup> Street, N.W., Suite 1200  
Washington, D.C. 20005-3096  
Telephone: 202 756 8000  
Facsimile: 202 756 8087

WDC99 1822684-1.043888.0335